

REMARKS

Applicants acknowledge receipt of the Office Action dated December 10, 2007. In that action, the Examiner: (1) rejected claims 1-5, 10, 12, 13, 15-19, 21, 22, 24, 31-36, 40, 45 and 49-63 under 35 USC 102(e) as anticipated by Bullock (U.S. Patent No. 6,564,875) ("Bullock"); (2) rejected claims 6-9, 38, 39, 41 and 46 under 35 USC 103(a) as being unpatentable over *Bullock*; and (3) lodged double patenting rejections under 37 CFR 1.78(b) and 35 U.S.C. 101 against claims 1-63 as conflicting with claims 1-63 of Application Nos. 10/552,039 and 10/522,099, and as claiming the same invention as that of claims 1-54 of copending Application No. 10/510,966. Applicants respectfully request reconsideration in view of the remarks that follow.

Status of the Claims

Claims 1-63 are currently pending.

Claims 1-63 are in original form.

Rejections under 35 U.S.C. 102(e) based on Bullock

Bullock discloses a device for protecting the internal threads of a tubular member from damage during handling. A tubular member 110 has an internally threaded portion 105 that is to be protected by a collar 120 and a locking member 115. The externally threaded portion 130 of the locking member 115 engages the internally threaded portion 105 of the tubular member 110 to couple the collar 120 and the locking member 115 to the tubular 110.

Claim 1

To establish a *prima facie* case of anticipation, the Examiner must show that *Bullock* discloses every element of the claim. Claim 1 includes "radially expanding and plastically deforming the first tubular member and the second tubular member." The Examiner fails to provide supporting text in *Bullock* for the claimed feature, and Applicants are unable to find such a teaching. The device taught in *Bullock* is intended for protection of threads during transit, and not for radial expansion and plastic deformation of the tubular members. Therefore, Applicants respectfully submit that *Bullock* does not support a *prima facie* case of anticipation, and claim 1 and its dependent claims are allowable over the cited art.

Claim 60-63

Claims 60-63 include similar features to those described above with respect to claim 1, and thus are allowable over *Bullock* for the same reasons as well as for the features these claims further include. Applicants respectfully submit that claims 60-63 are allowable over the cited art.

Rejections under 35 U.S.C. 103(a) over Bullock

Claims 6-9, 38, 39, 41 and 46

To establish a *prima facie* case of obviousness, the Examiner must show that *Bullock* teaches or suggests every element of the claim. As stated above, *Bullock* does not teach or suggest “radially expanding and plastically deforming the first tubular member and the second tubular member” of claim 1. Because claims 6-9, 38, 39, 41 and 46 depend from claim 1, they are allowable over *Bullock* for at least this reason.

Double Patenting Rejections

37 CFR 1.78(b)

Applicants intend to cancel the conflicting claims in Application Nos. 10/522,039 and 10/522,099 as soon as practicable.

35 U.S.C. 101

To sustain the double patenting rejection under 35 U.S.C. 101, the Examiner must show that the rejected claims 1-63 claim the “same invention” as that of claims 1-54 of Application No. 10/510,966, meaning that the two sets of claims are drawn to identical subject matter. A reliable test for determining double patenting under 35 U.S.C. 101 may be expressed as: can a claim in the application be literally infringed without literally infringing a corresponding claim in the reference application. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Thus, for example, if claim 1 of the present application could be literally infringed without literally infringing claim 1 of App. ‘966, then a double patenting rejection under 35 U.S.C. 101 cannot be sustained.

Claim 1 of the present application includes “coupling the ends of the first and second tubular members.” Claim 1 of App. ‘966 includes “threadably coupling the ends of the first and second tubular members.” Present claim 1 does not include the “threadably” feature of App. ‘966 claim 1. Therefore, a method including coupling tubulars without threads but having the other features of present claim 1 would literally infringe that claim, but would not literally infringe App.

‘966 claim 1 due to the absence of threads. Under the *In re Vogel* test, present claim 1 cannot be rejected for double patenting under 35 U.S.C. 101 as claiming the “same invention” of App. ‘966 claim 1.

For at least these reasons, Applicants respectfully request the rejections of claims 1-63 for double patenting under 35 U.S.C. 101 be withdrawn.

CONCLUSION

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. No new matter is introduced by way of amendment. It is believed that each ground of objection and rejection raised in the Office Action dated December 10, 2007 has been fully addressed. If any item has been overlooked, Applicants respectfully request the opportunity to supplement this response. If the Examiner feels that a telephone conference would expedite the resolution of this case, the Examiner is respectfully requested to contact the undersigned.

A one-month extension of time is petitioned herewith. In the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Conley Rose, P.C.’s Deposit Account Number 03-2769 (2725-10105).

Respectfully submitted,

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